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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,528

05/15/2001

Toru Suzuki

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11/05/2008

WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

11/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/854,528	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> John Hoffmann	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/14/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13 is/are pending in the application.  
     4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/2008 has been entered.

Claims 4-11 remain withdrawn.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 13 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

See the 3/9/2006 Office action

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

See the 3/9/2006 Office action

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Topchiashvili 6010983 in view of Wei 5518660.

See prior Office actions, in particular the 3/9/2006 Office action.

Claim 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Topchiashvili 6010983 and Takagi 4996177.

See prior Office actions, in particular the 3/9/2006 Office action.

Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita 4937214.

See prior Office actions, in particular the 3/9/2006 Office action.

### ***Response to Arguments***

Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive.

It is argued that one of ordinary skill would not expect that alumina could be oriented in a magnetic field. Examiner notes that there is no evidence to support this assertion. On the contrary, applicant has provided evidence that alumina is known to have a magnetic susceptibility. As pointed out previously, Topchiashvili teaches that materials other than high temperature superconductors can be used.

It is further argued that there is absolutely no motivation that would lead one to increase the magnetic field strength to orient alumina. Examiner disagrees, Takagi discloses the difficulty and desirability of creating oriented alumina sintered objects. Thus there is motivation to apply the known process/solution to creating oriented alumina.

As to the arguments regarding an emulsion mixture. Examiner fails to see there relevance. Topchiashvili's mixture would still be a slurry – even though it also contain an emulsion. The claim is comprising in nature and thus is open to having additional components.

It is argued that Applicants never argues that the only ceramics which can be oriented are the Topchiashvili ceramics. This is not very relevant, the rejection was based the admission that “orientation of the ceramic particles is only possible with Topchiashvili's ceramics.”

In an attempt to show the invention works Applicant points to attachments to the amendment filed July 28, 2006. And that Examiner has not disputed the results in the attachments. Examiner fails to understand what applicant means by "results". Examiner cannot dispute results because Examiner fails to see what applicant is trying to demonstrate with the attachments. Moreover, Examiner cannot even be sure which attachments applicant is referring to. See the second-to-last paragraph of page 6 of the 10/20/2006 where Examiner pointed out that Examiner could not find any relevance to the affidavit. And that is Applicant's burden to explain the data. As far as Examiner can tell Applicant has yet to offer any explanation of the data.

At present it appears that Applicant's position is that the attachments "clearly show that orientation of Applicants' ceramics has been achieved". Examiner fails to see it. The only attachment with probative value is the Declaration, but it has no data. Although item 5 of the Declaration refers to an "Attached Sheet" examiner is uncertain if such has the weight of evidence. The attached sheet is not one of the points averred by Declarant - someone might have attached a different sheet. Moreover, it appears to only pertain to Wei's ceramic, not applicants. Still further, such does not point out what was actually done to get the purported results. Examiner must be able to compare the experimental procedure used to obtain any results, to determine whether any results correspond to what is claimed in the invention. Even if the last sentence of the attached sheet was averred to in the declaration, such only relates to when the density is "adjusted" - the present claim does not require any adjusting step. Again, this is NOT to be taken as an assertion that there is any thing wrong or incorrect with the

declaration – except that Examiner does not see the relevance and applicant has not explained the relevance – even though Examiner has indicated he could not see any relevance. Examiner also notes there is a hand-written correction to the graphs – without any initial by the declarant. Applicant refers to Applicants' "ceramics" however the 'Attached sheet' refers to "alumina etc." At a bare minimum the declaration would need to point out exactly which ceramics were used to generate any data.

It is also argued that if the slurry satisfies the parameter A, B or C, that no adjustment step is necessary. No evidence is given to support this assertion. Since applicant has already admitted it is necessary, and since the 'attached sheet' of the declaration indicates that the adjustment is used to get the orientation, the argument is not persuasive. In other words: weighing the evidence that indicates adjustment is required, against an unsupported assertion that no adjustment is needed, the evidence significantly outweighs the argument.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Hoffmann  
Primary Examiner  
Art Unit 1791

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